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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,038	09/17/1999	AKEO MARUYAMA	0557-4774-2	9584

22850 7590 09/12/2003

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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EBRAHIMI DEHKORDY, SAEID

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 09/12/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/398,038

**Applicant(s)**

MARUYAMA, AKEO

**Examiner**

Saeid Ebrahimi-dehKordy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 April 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and -7-11 and 13-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \*   c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**FINAL ACTION**

Applicant's amendment filed on April 15 2003 has been entered and made of record.

Claims 6 and 12 are cancelled.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. <sup>1-5, 7-11 and 13-14</sup> Claims ~~1-13~~ are rejected under 35 U.S.C. 102(e) as being anticipated by Okimoto et al (U.S. patent 6,310,694).

Regarding claims 1, 10 and 11 Okimoto et al disclose: An electronic mail transmitting apparatus for transmitting document data via electronic mail, said electronic

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mail transmitting apparatus comprising: an application program for producing document data (please note Fig.1 column 9 lines 5-10 where the user uses the application program to create the data in the host computer) said application program having a function to send a print instruction to print the document data (please note Fig.1 column 9 lines 11-12 where the application program is been sent to the printer through the command form the application program) and a printer driver activated by the print instruction of said application program (please note Fig.3 column 9 lines 12-15 where the printer driver 30 is activated through the application program) said printer driver having a function to convert the document data provided by said application program into a predetermined data format and a function to transmit the converted document data via electronic mail (please note Fig.4 column 10 lines 32-40 where the print data is converted to the predetermined format in this case PDL also please note Fig.3 where utility 31a is transmitting email data, column 7 lines 15-21) wherein the printer driven' is capable of selecting the predetermined data format suitable for the electronic mail transmission from among a plurality of data formats other than a page description language (PDL) format (please note column 25 lines 28-34 where the Okimoto et al teach the variety of formats which could be used to fit the format of the transmitting side which could be any kinds of formats, PDL or else).

Regarding claim 2 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver transmits the converted document data by attaching to an electronic mail as an attachment file (please note

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Fig.7 column 13 lines 16-49 and column 14 lines 1-8 where the data is attached to the mail and transmitted to the printer of destination location).

Regarding claim 3 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a bit-map image format (column 21 lines 46-61).

Regarding claim 4 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a document reader software format (please note column 10 lines 33-38).

Regarding claim 5 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is a text format (please note column 25 lines 63-67).

Regarding claim 7 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said predetermined data format is one of a hyper text markup language (HTML) format and a standard generalized markup language (SGML) format (please note column 25 lines 63-67).

Regarding claim 8 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to manage information regarding electronic mail addresses (please note column 6 lines 15-28).

Regarding claim 9 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in claim 1, wherein said printer driver has a function to edit a text of an electronic mail to be transmitted (please note column 10 lines 66-67 and column 11 lines 1-15).

Regarding claim 13 Okimoto et al disclose: The processor readable medium as claimed in claim 11, wherein said third program code means includes program code means for inputting an electronic mail address of a remote party to which the document data is sent via electronic mail (please note column 6 lines 15-28).

Regarding claim 14 Okimoto et al disclose: The electronic mail transmitting apparatus as claimed in Claim 1, wherein said printer driver includes means for determining the predetermined data format suitable for the electronic mail transmission being performed (please note column 26 lines 1-4).

### **Conclusion**

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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**Contact Information**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to *Saeid Ebrahimi-Dehkordy* whose telephone number is (703) 306-3487.

The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 5:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles, can be reached at (703) 305-4712.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9314, or (703) 308-9052 (for **formal** communications; please mark  
"EXPEDITED PROCEDURE")


**Or:**

(703) 306-5406 (for **informal** or **draft** communications, please label  
"PROPOSED" or "DRAFT")

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist whose telephone number is (703) 305-4750.

*Saeid Ebrahimi-Dehkordy*  
Patent Examiner  
Group Art Unit 2622

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER

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June 25 2003